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EXAMINER
LIVERSEDGE, JENNIFER L

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3628	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/005,539	Applicant(s) POH WONG, KENNETH TIEN	
	Examiner Jennifer Liversedge	Art Unit 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

The disclosure is objected to because of the following informalities: page 12, line 11 should refer to "payer company 201" rather than "payer company 210".

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-2, 4-6 and 8-10 are rejected under 35 U.S.C. 102(a) as being anticipated by European Patent Application EP 0 949 596 A2 to Golvin et al. (further referred to as Golvin).

Regarding claim 1, Golvin discloses a method of processing an electronic transfer of funds from a payer account held at a payer financial institution via a financial settlement network to a payee account in a currency that may be the same as or different from the funds in the payer account, which transfer is initiated by a payment instruction transmitted by the payer to a payment gateway associated with the financial settlement network (Figure 1; column 1, paragraph 5; column 2, paragraph 8; column 4, paragraph 17); said method including the steps of:

a) providing at the payment gateway, a mapping between the payer account and at least one credit card account in a currency nominated from those currencies supported by the payer financial institution for settlement purposes (column 1, paragraph 6; column 2, paragraph 9; column 5, paragraph 20);

b) providing at the payer financial institution, a foreign exchange bridge for determining internally any foreign exchange rates between payer accounts and the mapped credit card accounts (Figure 1; column 1, paragraph 5; column 2, paragraph 9; column 5, paragraphs 19-20; column 8, paragraph 35);

c) the payment instruction transmitted by the payer including a payer account number for debiting purposes, a payment amount and a payment currency code (Figures 1 and 10; column 1, paragraph 5; column 2, paragraph 9; column 5, paragraphs 19-20; column 7, paragraphs 30-31; column 10, paragraphs 44-45);

d) the payment gateway selecting, in response to the payment instruction, a credit card account wherein:

(i) if a credit card account having the same currency as the payment currency code is mapped to the payer account number, that mapped credit card account (column 7, paragraph 31; column 10, paragraphs 44-48);

(ii) otherwise a credit card account in the same currency as the payer account currency (Figure 1; column 1, paragraph 5; column 2, paragraph 9; column 7, paragraph 31; column 10, paragraphs 44-48);

e) the payment gateway creating a payment request message, including the payment amount, payment currency code and the selected credit card account details

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and passing the payment request message to the financial settlement network (Figures 1 and 10; column 10, paragraphs 44-48); and

f) the financial settlement network routing the payment request message to the payer financial institution wherein:

i) if the payment currency code is for a currency code not supported by the payer financial institution, the financial network effects the foreign exchange conversion externally of the payer financial institution (column 1, paragraph 6; column 2, paragraphs 8-9; column 5, paragraphs 19-20; column 7, paragraph 30); or

ii) if the payment currency code is for a currency supported by the payer financial institution, the payer financial institution effects any foreign exchange conversion required via the system bridge (column 1, paragraph 5; column 2, paragraphs 8-9; column 7, paragraph 31).

Regarding claim 2, Golvin discloses the method wherein each payer account is mapped to respective credit card accounts in the currencies supported for settlement (column 1, paragraph 5; column 2, paragraph 9; column 5, paragraphs 19-20).

Regarding claim 4, Golvin discloses the method wherein the foreign exchange bridge initiates return of a payment authorization message to the financial settlement network, which authorization message includes a currency code and amount for settlement of the funds transfer (Figure 10; column 10, paragraphs 44-48).

Regarding claims 5 and 6, Golvin discloses the method wherein, upon the payer financial institution ascertaining that there are sufficient funds in the payer account to effect the transfer, the payer financial institution returns a payment authorization to the financial settlement network where the authorization includes a settlement currency code and settlement amount (Figure 4; column 8, paragraphs 37-38; column 9, paragraph 41).

Regarding claim 8, Golvin discloses the method wherein step (f)(i), the financial settlement network calculates foreign exchange between settlement currency and the currency of funds in the payer account (column 1, paragraph 5; column 2, paragraphs 8-9; column 4, paragraph 17; column 5, paragraphs 19-20).

Regarding claim 9, Golvin discloses the method wherein step (f)(ii), the system bridge calculates foreign exchange between settlement currency and the currency of funds in the payer account (column 1, paragraph 5; column 2, paragraphs 8-9; column 4, paragraph 17; column 5, paragraphs 19-20).

Regarding claim 10, Golvin discloses a method of processing an electronic transfer of funds, from a payer account via a financial settlement network to a payee account held at a payee financial institution in a currency that may be the same or different from funds in the payer account, which transfer occurs in response to a payment instruction transmitted by the payer to a payment gateway associated with the

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financial settlement network (Figure 1; column 1, paragraph 5; column 2, paragraph 8; column 4, paragraph 17); said method including the steps of:

a) providing at the payment gateway, a mapping between a plurality of payment currencies and at least one acquiring account in a currency supported by acquiring financial institutions (column 1, paragraph 6; column 2, paragraphs 8-9; column 4, paragraph 17; column 5, paragraphs 19- 20);

b) providing at each acquiring financial institution, a foreign exchange bridge for determining internally any foreign exchange rates between the mapped credit acquiring accounts and payee accounts (Figure 1; column 1, paragraph 5; column 2, paragraph 9; column 5, paragraphs 19-20; column 8, paragraph 35);

c) the payment instruction including a payment amount, payment currency code and acquiring account details identifying the payee financial institution (Figures 1 and 9-10; column 1, paragraph 5; column 2, paragraph 9; column 5, paragraphs 19-20; column 7, paragraphs 30-31; column 10, paragraphs 44-45);

d) the payment gateway selecting, in response to the payment instruction, an acquiring account wherein:

(i) if an acquiring account for the payee is mapped to a payment currency having the same currency code as the payment currency code, that acquiring account (column 7, paragraph 31; column 10, paragraphs 44-48); or

(ii) if none of the mapped payment currencies correspond to the payment currency code, generating an error message (column 7, paragraph 30; column 9, paragraph 43; column 10, paragraphs 44-45).

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e) the payment gateway creating a payment request message, including the payment amount, payment currency code and acquiring account details and passing the payment request message to the financial settlement network (Figures 1 and 10; column 10, paragraphs 44-48); and

f) the financial settlement network routing the payment request message to the acquiring financial institution holding the acquiring account for the payee, wherein:

i) if the payment currency code is for a currency code not supported by the acquiring financial institution, the financial network effects the foreign exchange conversion externally of the acquiring financial institution (column 1, paragraph 6; column 2, paragraphs 8-9; column 5, paragraphs 19-20; column 7, paragraph 30); or

ii) if the payment currency code is for a currency supported by the acquiring financial institution, the acquiring financial institution effects any foreign exchange conversion required via the system bridge (column 1, paragraph 5; column 2, paragraphs 8-9; column 7, paragraph 31).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Golvin as applied to claim 1 above, and further in view of Pub No. US 2002/0016769 A1 to Barbara et al. (further referred to as Barbara).

Golvin does not disclose the method wherein each currency supported by the payer financial institution may be mapped directly to a bank identification number. However, Barbara discloses the method wherein each currency supported by the payer financial institution may be mapped directly to a bank identification number (page 5, paragraph 63; page 10, paragraph 95). It would be obvious to one of ordinary skill in the art at the time of the invention to modify the electronic exchange and settlement method as disclosed by Golvin to adapt the linking of currencies associated with transaction through a bank identification number as disclosed by Barbara. He motivation would be that using a standard identification to record the parameters of the account, such as currency, would be an efficient way to maintain this piece of data associated with the account and transactions therein.

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Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Golvin as applied to claim 1 above, and further in view of Pub No. US 2001/0032878 A1 to Tsiounis et al. (further referred to as Tsiounis).

Golvin does not disclose the method wherein, upon the payer financial institution ascertaining that there are insufficient funds in the payer account to effect the transfer, the payer financial institution returns a payment decline to the financial settlement network. However, Tsiounis discloses the method wherein, upon the payer financial institution ascertaining that there are insufficient funds in the payer account to effect the transfer, the payer financial institution returns a payment decline to the financial settlement network (page 11, paragraph 140). It would be obvious to one of ordinary skill in the art at the time of the invention to modify the electronic exchange and settlement method as disclosed by Golvin to adapt sending a message if insufficient funds are found for processing the transaction. The motivations would be that if during the verification of the transaction, insufficient funds are found to be available, the system would want to prohibit the transaction from being processed and instead to notify the participant that they lack funds available such that alternative sources of funds or processes can be identified.

Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Golvin as applied to claim 10 above, and further in view of "RBI to be regulatory authority for E-com" in The Statesman Aug 1999 (further referred to as Statesman).

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Golvin does not disclose the method wherein acquiring accounts are held at the payee financial institution and where funds are transferred internally from the acquiring account to the payee account. However, Statesman discloses the method wherein acquiring accounts are held at the payee financial institution and where funds are transferred internally from the acquiring account to the payee account (page 2, lines 1-4). It would be obvious to one of ordinary skill in the art at the time of the invention to modify the electronic exchange and settlement method as disclosed by Golvin to adapt the use of internal transfers as disclosed by Statesman. The motivation would be that accounts can be held at one financial institution and that parties can desire to transfer funds amongst those accounts, thereby an internal, or intra-bank, transfer.

Claims 13-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Golvin, and further in view of Pub No. US 2003/0208440 A1 to Harada et al. (further referred to as Harada).

Regarding claim 13, Golvin does not disclose the method wherein acquiring accounts are held at an agent financial institution that is linked to a subsidiary financial network of which the payee financial institution is a member. However, Harada discloses the method wherein acquiring accounts are held at an agent financial institution that is linked to a subsidiary financial network of which the payee financial institution is a member (page 5, paragraphs 58-59). It would be obvious to one of ordinary skill in the art at the time of the invention to modify the electronic exchange and

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settlement method as disclosed by Golvin to adapt the use of "in-system" connections and networks as disclosed by Harada. The motivation would be to encourage financial institutions to participate in a network in order to achieve greater efficiency and cooperation amongst participating members.

Regarding claim 14, Golvin does not disclose the method wherein funds are transferred externally from the acquiring account to the payee account in accordance with clearing mechanisms of the subsidiary financial network. However, Harada discloses the method wherein funds are transferred externally from the acquiring account to the payee account in accordance with clearing mechanisms of the subsidiary financial network (page 1, paragraph 5; page 4, paragraph 46-48; page 5, paragraphs 58-59). It would be obvious to one of ordinary skill in the art to modify the electronic exchange and settlement method as disclosed by Golvin to adapt the use of clearing mechanisms for external funds transfers. The motivation would be that when transactions are conducted externally of the network that certain protocols regarding clearing would be undertaken to ensure the integrity of the transaction.

Regarding claim 15, Golvin does not disclose the method wherein the acquiring accounts mapped at step (a) include accounts held at acquiring financial institutions that are also agent financial institutions, which are agents for payments made in a currency supported by the subsidiary financial network. However, Harada discloses the method wherein the acquiring accounts mapped at step (a) include accounts held at

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acquiring financial institutions that are also agent financial institutions, which are agents for payments made in a currency supported by the subsidiary financial network (page 5, paragraphs 51, 54, 58-59; page 7, paragraph 78). It would be obvious to one of ordinary skill in the art at the time of the invention to modify the electronic exchange and settlement method as disclosed by Golvin to adapt the use of agent agencies and acquiring agencies being one and the same within a currency operation as disclosed by Harada. The motivation would be that financial institutions within the network would operate as agents such as to facilitate currency exchange by way of conducting normal business practices in which currency exchange could be conducted by members of the organization.

Regarding claim 16, Golvin discloses the method wherein the selection of the acquiring account at step (d) instead proceeds as follows:

(i) if the payee account is held at an acquiring financial institution, the acquiring account at the acquiring financial institution mapped to the payment currency is selected (column 7, paragraph 31);

(ii) else, if the payment currency corresponds to the currency supported by a subsidiary financial network, the acquiring account at the agent financial institution mapped to the payment currency is selected (column 7, paragraphs 30 and 37-38; column 9, paragraph 43); or

(iii) if none of the mapped payment currencies corresponds to the payment currency, generating an error message (column 7, paragraph 30; column 9, paragraph 43; column 10, paragraphs 44-45).

Regarding claim 17, Golvin discloses a method of processing an electronic transfer of funds, from a payer account via a financial settlement network to a payee account held at a payee financial institution in a currency that may be the same or different from funds in the payer account, which transfer occurs in response to a payment instruction transmitted by the payer to a payment gateway (Figure 1; column 1, paragraph 5; column 2, paragraph 8; column 4, paragraph 17); said method including the steps of:

a) providing at the payment gateway, a mapping between a plurality of payment currencies and at least one acquiring account in a currency supported by acquiring financial institutions, (column 1, paragraph 6; column 2, paragraphs 8-9; column 4, paragraph 17; column 5, paragraphs 19- 20);

b) providing at each acquiring financial institution, a foreign exchange bridge for determining internally any foreign exchange rates between the mapped credit acquiring accounts and payee accounts (Figure 1; column 1, paragraph 5; column 2, paragraph 9; column 5, paragraphs 19-20; column 8, paragraph 35);

c) the payment instruction including a payment amount, payment currency code and acquiring account details identifying the payee financial institution (Figures 1 and 9-

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10; column 1, paragraph 5; column 2, paragraph 9; column 5, paragraphs 19-20; column 7, paragraphs 30-31; column 10, paragraphs 44-45);

d)(i) if the payee financial institution is an acquiring financial institution, the payment gateway selecting, in response to the payment instruction, an acquiring account wherein (column 7, paragraph 31; column 10, paragraphs 44-48) wherein:

(A) if an acquiring account for the payee is mapped to a payment currency having the same currency as the payment currency code, that acquiring account (column 7, paragraph 31); or

(B) if none of the mapped payment currencies for the acquiring financial institution corresponds to the payment currency code, generating an error message (column 7, paragraph 30; column 9, paragraph 43; column 10, paragraphs 44-45).

(ii)(A) if an acquiring account held at an agent financial institution for the subsidiary clearing network has the same currency as the payment currency code, that acquiring account); or

(B) if none of the mapped payment currencies for the agent financial institution corresponds to the payment currency code, generating an error message (column 7, paragraph 30; column 9, paragraph 43; column 10, paragraphs 44-45);

e) the payment gateway creating a payment request message, including the payment amount, payment currency code and acquiring account details and passing the

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payment request message to the financial settlement network (Figures 1 and 10; column 10, paragraphs 44-48); and

f) the financial settlement network routing the payment request message to the acquiring financial institution holding the acquiring account for the payee, wherein:

i) if the payment currency code is for a currency not supported by the acquiring financial institution, the financial network effects the foreign exchange conversion externally of the acquiring financial institution (column 1, paragraph 6; column 2, paragraphs 8-9; column 5, paragraphs 19-20; column 7, paragraph 30); or

ii) if the payment currency code is for a currency supported by the acquiring financial institution, the acquiring financial institution effects any foreign exchange conversion required via the system bridge (column 1, paragraph 5; column 2, paragraphs 8-9; column 7, paragraph 31).

Golvin does not disclose wherein acquiring financial institutions include agent financial institutions linked to subsidiary national clearing networks; the payment gateway determining whether the payee financial institution is a member of the financial settlement network and if the payee financial institution is a member of a subsidiary national network, the payment gateway selecting in response to the payment instruction, an acquiring account.

However, Harada discloses wherein acquiring financial institutions include agent financial institutions linked to subsidiary national clearing networks; the payment gateway determining whether the payee financial institution is a member of the financial settlement network and if the payee financial institution is a member of a subsidiary

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national network, the payment gateway selecting in response to the payment instruction, an acquiring account (page 1, paragraph 5; page 4, paragraphs 46-48; page 5, paragraphs 58-59).

It would be obvious to one of ordinary skill in the art at the time of the invention to modify the electronic exchange and settlement method as disclosed by Golvin to adapt the use of "in-system" connections, memberships and networks as disclosed by Harada. The motivation would be to encourage financial institutions to participate in a network in order to achieve greater efficiency and cooperation amongst participating members.

Regarding claim 18, Golvin does not disclose the method wherein the payment gateway determines whether the payee financial institution is a member of the financial settlement network by checking the identifying details provided in the payment instruction. However, Harada discloses the method wherein the payment gateway determines whether the payee financial institution is a member of the financial settlement network by checking the identifying details provided in the payment instruction (page 3, paragraphs 35, 38 and 41; page 4, paragraphs 42 and 45; page 5, paragraphs 51 and 58-59). It would be obvious to one of ordinary skill in the art at the time of the invention to modify the electronic exchange and settlement method as disclosed by Golvin to adapt the use of determining network status via a payment instruction as disclosed by Harada. The motivation would be that payment instruction in electronic funds transfer mechanisms include relevant information for conducting a transaction and whether a financial institution is part of a network or not would be

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information critical to processing the transaction and thus included in the instruction data.

Regarding claim 19, Golvin discloses the method wherein the error message generated indicates that the payment currency is not supported by the payee financial institution (column 7, paragraph 30; column 9, paragraph 43; column 10, paragraphs 44-45).

Regarding claim 20, Golvin does not disclose the method wherein the error message generated indicates that the payment currency is not supported by the subsidiary national clearing network. However, Harada discloses the method wherein the error message generated indicates that the payment currency is not supported by the subsidiary national clearing network (page 5, paragraphs 58-59). It would be obvious to one of ordinary skill in the art at the time of the invention to modify the electronic exchange and settlement method as disclosed by Golvin to adapt the use of an error message if the network does not support a currency. The motivation would be that if the system were unable to conduct the transaction as requested, then an error message would need to be send such that system user could alter the instructions or exit the session.

Conclusion

Any inquiry concerning this communication should be directed to Jennifer Liversedge whose telephone number is 571-272-3167. The examiner can normally be reached on Monday – Friday, 8:30 – 5 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sam Sough can be reached at 571-272-6799. The fax number for the organization where the application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jennifer Liversedge

Examiner

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